

Applic. No. 10/782,323
Amdt. dated July 25, 2006
Reply to Office action of May 3, 2006

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Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-8 remain in the application.

In the second paragraph on page 2 of the above-identified Office action, claims 1, 2, 6, 7, and 8 have been rejected as being obvious over Frankenberger et al. (U.S. Patent No. 6,663,550 B2) (hereinafter "Frankenberger") in view of Maul et al. (U.S. Patent No. 6,578,846 B2) (hereinafter "Maul") under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claim 1 calls for, *inter alia*:

Applic. No. 10/782,323
Amdt. dated July 25, 2006
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a gripper opener configured to open the second grippers
guiding the trailing edges of the sheets when the sheets reach
the sheet decurler.

It is noted that the corporate assignee of the Frankenberger
reference and the Maul reference is also the assignee of the
instant application. Therefore, applicants are very familiar
with both the Frankenberger and Maul references.

It is respectfully believed that the Examiner seems to have
overlooked that fact that Maul discloses a sheet decurler.
More specifically, Maul discloses an unrolling device (column
10, lines 21-26). The unrolling device is the same as a sheet
decurler. However, Maul discloses that when the sheet is
decurled, neither the leading edge grippers nor the trailing
edge grippers are opened (column 10, lines 21-26). Instead,
Maul explicitly discloses that the distance between the
leading edge grippers and the trailing edge grippers is
temporarily decreased during decurling.

On page 3 of the Office action, the Examiner makes an
allegation that "it would have been obvious to one of ordinary
skill in the art to open the grippers near the decurler so
that the sheet can be decurled." Applicants respectfully
disagree with the Examiner. More specifically, as seen from

Applic. No. 10/782,323
Amdt. dated July 25, 2006
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the above given remarks, Maul explicitly discloses a decurler which decurls the sheet while the distance between the leading edge gripper and the trailing edge gripper is reduced.

Therefore, it is respectfully believed that the Examiner's allegation with respect to the opening of the grippers during decurling is not accurate.

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The references do not show or suggest a gripper opener configured to open the second grippers guiding the trailing edges of the sheets when the sheets reach the sheet decurler, as recited in claim 1 of the instant application.

The Examiner correctly stated that Frankenberger does not disclose a trailing edge gripper.

The Maul reference discloses a sheet unrolling device in which the distance between the leading edge grippers and the trailing edge grippers is temporarily decreased during decurling. Maul does not disclose a gripper opener that is configured to open a trailing edge gripper when a sheet reaches the decurler. This is contrary to the invention of

Applic. No. 10/782,323
Amdt. dated July 25, 2006
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the instant application as claimed, in which a gripper opener is configured to open the second grippers guiding the trailing edges of the sheets when the sheets reach the sheet decurler.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

Since claim 1 is believed to be allowable, dependent claims 2 and 6 are believed to be allowable as well.

Claims 7 and 8 call for, *inter alia*:

releasing the trailing edge from the second grippers and decurling the sheet with the sheet decurler.

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The references do not show or suggest releasing the trailing edge from the second grippers and decurling the sheet with the sheet decurler, as recited in claims 7 and 8 of the instant application.

Applic. No. 10/782,323
Amdt. dated July 25, 2006
Reply to Office action of May 3, 2006

The Examiner correctly stated that Frankenberger does not disclose releasing a trailing edge from a second gripper and decurling the sheet with the sheet decurler.

The Maul reference discloses a sheet unrolling device in which the distance between the leading edge grippers and the trailing edge grippers is temporarily decreased during decurling. Maul does not disclose releasing a trailing edge from a second gripper and decurling the sheet with the sheet decurler. This is contrary to the invention of the instant application as claimed, which recites releasing a trailing edge from a second gripper and decurling the sheet with the sheet decurler.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

It is appreciatively noted from page 3 of the Office action that claims 3-5 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The claims have not been amended as indicated by the Examiner, as the claims are believed to be patentable in their existing form.

Applic. No. 10/782,323
Amdt. dated July 25, 2006
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It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1, 7, or 8. Claims 1, 7, and 8 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-8 are solicited.

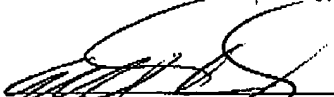
In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

Applic. No. 10/782,323
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Please charge any other fees which might be due with respect
to Sections 1.16 and 1.17 to the Deposit Account of Lerner
Greenberg Stemer LLP, No. 12-1099.

Respectfully submitted,



For Applicant(s)

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